

Response to Office Action
S/N 10/772973

REMARKS

A. Status of Claims

Claims 4, 10, and 14-19 are pending.

B. §102(e) Rejection

The Examiner has rejected claims 4, 10 and 15-17 under 35 USC 102(e) as being anticipated by U.S. Patent Application Publication 2002/0071287 belonging to Haase ("Haase"). A claim is anticipated, however, only if a single prior art reference expressly or inherently describes each and every element as set forth in the claim. *Verdegaal Bros., Inc. v. Union Oil Co*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

1. Applicants' Claimed Invention

Applicants' preferred embodiment of its laser device uses laser beams that are emitted substantially simultaneously. See specification paras. [0015] and [0023]. Applicants' independent claims 4 and 10 specifically claim that at least two of the laser beams are emitted substantially simultaneously. Claims 15-17 depend from claim 10 and therefore also include the limitation.

2. Haase's Disclosure

Haase discloses a laser pointing device with multiple alternative lasers to contrast the color of any background surface. See Haase, para. [0020]. The Examiner states that Haase teaches simultaneous emission of multiple laser beams. Applicants respectfully disagree. The Examiner points to the following statement in Haase: "The switches or power regulating circuits may allow the user to periodically flash any one laser or alternately flash two or more lasers." Haase, para [0016]. Rather than suggesting simultaneous operation of multiple lasers, however, this statement instead discloses that a single laser can flash, two lasers can flash *alternately*, or several lasers can flash *alternately*. The definition of "alternately" is "to take turns" or "interchanged repeatedly one for another." *Dictionary.com Unabridged (v 1.1)*. Random House, Inc. 06

Response to Office Action
S/N 10/772973

Nov. 2008 <Dictionary.com <http://dictionary.reference.com/browse/alternately>>. Thus, "alternately" has the opposite meaning of "simultaneously."

Consistent with the common meaning of "alternately," Haase expressly instructs that the disclosed laser pointer is designed for "preventing more than one laser element from operating at a given time." Haase, para [0016]. Haase instructs that operating the lasers alternately is necessary in order to "reduce[e] the need to precisely align the laser beams to point at the same spot, since the lack of alignment will not be revealed by simultaneous use of the lasers." *Id.* Further, Haase's laser pointer includes a switch or electronic lockout circuit so that only one laser can be actuated at a time. *Id.* Accordingly, Haase fails to disclose emitting two or more laser beams substantially simultaneously.

3. Conclusion

Because the laser beams disclosed in Haase are not emitted at the same time, Haase does not disclose each and every element as set forth in claims 4, 10, and 15-17, either expressly or inherently. Accordingly, Haase does not anticipate Applicants' claimed invention, and Applicants respectfully request that this rejection be withdrawn.

C. §103(a) Rejection

The Examiner has rejected claims 10 and 14-19 under 35 USC 103(a) as being unpatentable over U.S. Patent 5,046,494 issued to Searfoss et al. ("Searfoss") in view of Haase. A claim is *prima facie* obvious only if the combined prior art references teach or suggest all the claim limitations. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966); MPEP §2143. However, it is improper to combine references when one teaches away from the combination or renders the device inoperable for its intended purpose. MPEP § 2143.01; see also *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, 12 (2007). Moreover, a prior art reference must be considered in its entirety, including portions that would teach away from the claimed invention. MPEP §2141.02; *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Response to Office Action
S/N 10/772973

1. Searfoss teaches away from moving its device relative to the skin of the patient.

Applicants' independent claim 10 and dependent claims 15-19 all contain the limitation that the device be freely moved relative to the surface of the skin of a patient. Searfoss, however, teaches away from applying light energy to a patient's skin because Searfoss teaches a vision therapy device that is aimed solely at a patient's eyes so that the patient *observes* fields of incandescent light. Searfoss admits that non-ocular treatments have not been effective in providing physiological effects. Column 1, lines 11-16. Thus, Searfoss overtly teaches away from using light applied to anywhere but the eyes of patient. Eyes are not skin.

It is improper to combine references when one teaches away from the combination. MPEP § 2141.02. Because Searfoss teaches away from a therapeutic device for applying energy to a patient's skin, Searfoss cannot be combined with Haase to render Applicant's claimed invention obvious, and therefore no *prima facie* case of obviousness has been made. Accordingly, Applicants respectfully request that this rejection be withdrawn.

2. Modification of Searfoss to apply it to skin would render it inoperable.

Observing light fields is critical to Searfoss's invention. Throughout the specification, claims and figures, Searfoss teaches that the invention is something meant to be observed by the patient's eyes. For example, Searfoss explains that the invention provides methods "for more efficaciously utilizing light in order to achieve a therapeutic effect in the *observer*." Searfoss, column 1, lines 61-63 (emphasis added). Moreover, "[t]he apparatus of the present invention provides a *means for displaying* to an observer a field of light . . ." Searfoss, column 1, lines 66-67 (emphasis added). Searfoss's apparatus "provides a display of light *to an observer peering therein*." Searfoss, column 3, lines 45-47 (emphasis added). Finally, Searfoss emphasizes that it is important to align the light source to the "field of view of the observer." Searfoss, column 2, line 19 and column 3, lines 16-22.

Response to Office Action
S/N 10/772973

To modify Searfoss and make it a handheld device using multiple laser energy sources that are freely moved relative to the surface of the skin of a patient would render Searfoss inoperable as a vision therapy device because light would not enter the eyes. Thus, because Searfoss cannot be combined with Haase to render Applicant's claimed invention obvious, no *prima facie* case of obviousness has been made. MPEP § 2143.01. Accordingly, Applicants respectfully request that that this rejection be withdrawn.

3. The Examiner has not demonstrated a sufficient reason for combining Haase and Searfoss.

Additionally, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with *some rational underpinning* to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), *quoted in KSR*, 550 U.S. ___, 14 (2007) (emphasis added); MPEP §§ 2142 and 2143.

The Examiner fails to demonstrate a sufficient reason for combining Haase and Searfoss. The Examiner suggests that a person designing laser devices for stimulating the sympathetic and parasympathetic nervous systems would be motivated to combine a vision therapy device with the latest developments of laser pointers. Applicants respectfully disagree. There is no reason with a rational underpinning that person of ordinary skill in the art of therapeutic laser devices would look to laser pointers to solve any problem. Haase and Searfoss are both concerned only with producing visual displays, and there is no rational reason for a person skilled in the art of therapeutic laser devices to consider or combine Haase and Searfoss to produce Applicants' claimed invention.

Because the Examiner has not articulated a rational reason for combining Searfoss and Haase, they should not be combined to establish the obviousness of Applicants' claimed invention. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Response to Office Action
S/N 10/772973

4. Haase and Searfoss fail to disclose elements of Applicants claimed invention.

While Haase and Searfoss cannot be combined for an obviousness determination, assuming *arguendo* that they are, their combination fails to disclose claimed elements of Applicants' invention. A claim is *prima facie* obvious only if the combined prior art references teach or suggest all the claim limitations. MPEP §2143.

(a) Simultaneous laser emissions not disclosed

Applicants' independent claim 10 specifically claims that at least two of the laser beams are emitted simultaneously. Claims 15-19 depend from claim 10 and therefore also include the limitation.

As explained above with respect to the Examiner's anticipation rejection, Haase fails to teach simultaneously emitting two or more laser beams. Searfoss also fails to teach simultaneously emitting two or more laser beams. Searfoss teaches displaying a field of light to the observer. Searfoss, column 4, lines 29-31. There can be one field of light observed by both eyes simultaneously or two fields of light, one observed by the right eye and one observed by the left eye. *Id.*, Figures 1 and 3. Searfoss does not teach, however, that if there are multiple fields of light that they will operate substantially simultaneously. Instead, Searfoss specifically teaches that the therapy sessions will be enhanced by isolating the observer from distractions and allowing the observer to concentrate on the light display. *Id.*, column 4, lines 66-68, and column 7, lines 1-3. Searfoss's objective suggests that if two different light sources were applied simultaneously, the observer would be distracted and disoriented and find it difficult to concentrate. Accordingly, both Haase and Searfoss fail to teach substantially simultaneously operating two or more laser energy sources.

Because neither Haase nor Searfoss teach simultaneously emitting laser beams, a *prima facie* case of obvious is not made. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Response to Office Action
S/N 10/772973

(b) Application of warm and cool laser energy not disclosed

Haase and Searfoss fail to teach or suggest applying warm and cool laser energy to a patient's skin. As explained above, Haase teaches a laser pointer having multiple alternative laser colors to optimize contrast with a background surface. Haase is concerned with improving the visual display of the laser pointer for an observer. Haase does not teach or suggest applying warm or cool laser energy to a patient's body.

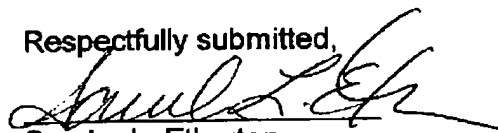
Searfoss also does not teach applying warm and cool laser energy to a person's body. Searfoss teaches a vision therapy device in which a patient observes light displays. Searfoss, column 3, lines 45-49. In particular, Searfoss discloses an apparatus into which an observer gazes at filtered incandescent light. *Id.*, column 3, lines 52-56, 64-65, and column 4, lines 8-11. Searfoss does not suggest that the filters cause warm and cool light to be emitted.

Because neither Haase nor Searfoss teach a device that emits warm and cool colors, a *prima facie* case of obvious is not made. Accordingly, Applicants respectfully request that this rejection be withdrawn.

CONCLUSION

Applicants respectfully submit that all objections and rejections have been traversed, and that the application is in form for issuance. Applicants respectfully request that the Examiner allow the application to proceed to issuance.

Respectfully submitted,



Sandra L. Etherton
Registration No. 36,982

Customer No. 33354
Etherton Law Group, LLC
5555 E. Van Buren St., Suite 100
Phoenix, Arizona 85005-3422
Tel: 602-681-3331 Fax: 602-681-3339